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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/782,528	02/13/2001	Gera M. Strommer	2649/1F631US1	7543

7590

12/14/2004

DARBY & DARBY P.C
805 Third Avenue
New York, NY 10022

EXAMINER

MANTIS MERCADER, ELENI M

ART UNIT	PAPER NUMBER
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3737

64

DATE MAILED: 12/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/782,528

Applicant(s)

STROMMER ET AL.

Examiner

Eleni Mantis Mercader

Art Unit

3737

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-15, 19, 20, 35, 42, 65, 85, 110 and 120-202 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-15, 19, 20, 35, 42, 65, 85, 110 and 120-202 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's arguments filed on 10/06/2004 have been fully considered but they are not persuasive. The Examiner respectfully disagrees with the Representative's assertion regarding the inappropriateness of the Final Action because of the representation that the limitation introduced regarding elimination of computations was a "substantive amendment", (see the response dated 12/19/2003, 4th Full Paragraph). Then in the response of 09/29/2004, the Representative states that this amendment was "not a substantive limitation".

Regardless, a new rejection is applied to address the current claims.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 3-15, 19-20, 35-35, 42, 65, 85, 110, 120-202 are rejected under 35 U.S.C. 103(a) as being unpatentable over Paltieli'029, of record.

Paltieli'029 teach the use of transponders on the ultrasonic imager and on the invasive instrument as well as a processor or a computer which receives the information from the transponders and computes their positions along with the position and orientation of the ultrasound image plane associated with the imager (see col. 6, lines 66-col.7, line 61).

Paltieli'029 further teaches the common coordinate system (see in claim 19 the common coordinate system or as states therein "reference").

Paltieli'029 do not explicitly teach the use of gating in order to monitor the organ-timing signal.

In the same field of endeavor, Schweikard et al.'981 teach gating or triggering, as is known in the art, of an inspected organ monitor interface, connected to the processor and to an organ monitor, the organ monitor monitoring an organ timing signal associated with an inspected organ (see Figure 8, see col. 6, lines 51-65 and see claims 11 and 23). This triggering or gating is performed so that accurate treatment is performed compensating for movement of the patient such as movement of the chest due to respiration (see col. 2, lines 10-67 and col. 3, lines 1-22).

It would have been obvious to one skilled in the art at the time that the invention was made to have modified Paltieli'029 and incorporated the triggering or gating of therapy on the basis of monitoring motion as taught by Schweikard et al.'981 in order to compensate for movement such as respiration especially when the surgical treatment is targeted in an area of interest such as in the thorax where there is abdominal movement rather than in an area of minimal movement such as the spine.

Different type of therapeutic devices and different type of imagers would have been an obvious modification to one skilled in the art at the time that the invention was made as that would depend on the type of imager available and the surgical procedure of interest.

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eleni Mantis Mercader whose telephone number is 703 308-0899. The examiner can normally be reached on Mon. - Fri., 8:00 a.m.-6:30 p.m..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on (703) 308-3552. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Eleni Mantis Mercader
Primary Examiner
Art Unit 3737

EMM